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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,557	07/08/2003	Saturo Yamada	JP919970025US2(RE) (8728-	8603
46069	7590	12/11/2007	EXAMINER	
F. CHAU & ASSOCIATES, LLC 130 WOODBURY ROAD WOODBURY, NY 11797			KUMAR, SRILAKSHMI K	
		ART UNIT	PAPER NUMBER	
		2629		
		MAIL DATE		DELIVERY MODE
		12/11/2007		PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.	Applicant(s)
10/615,557	YAMADA ET AL.
Examiner	Art Unit
Srilakshmi K. Kumar	2629

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.138(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 05 September 2007.  
2a) This action is FINAL.                    2b) This action is non-final.  
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-14 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) Claim(s) 1-7 and 14 is/are allowed.  
6) Claim(s) 8-13 is/are rejected.  
7) Claim(s) \_\_\_\_\_ is/are objected to.  
8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.  
10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
    1. Certified copies of the priority documents have been received.  
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO/SB/08)  
    Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
    Paper No(s)/Mail Date, \_\_\_\_\_.  
5) Notice of Informal Patent Application  
6) Other: \_\_\_\_\_.

### **DETAILED ACTION**

The following office action is in response to the Pre Appeal Conference Request. Claims 1-14 are pending.

#### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 8 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 8 is directed to “Computer readable code stored on computer readable storage medium and executable by a computer system...” which is directed to non-statutory subject matter as not being tangibly embodied in a manner so as to be executable. According to the USPTO Interim Guidelines for Patent Subject Matter Eligibility, computer codes are neither computer components nor statutory processes, as they are not “acts” being performed nor do they define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program’s functionality to be realized. Therefore, a claim that recites language such as “Computer readable code...comprising...” is NOT statutory.

Applicant should note, however, that claims directed to a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer’s functionality to be realized, and is thus statutory, PROVIDED the specification does NOT disclose that the computer-readable medium is a signal, waveform, or

carrier wave. Applicant is directed to the USPTO Interim Guidelines for Patent Subject Matter Eligibility pages 53-55 for further information.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 9-13, [REDACTED] are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to independent claims 9 and 13, applicant recites the limitation “to scroll within a displayed window by manipulation of the lever input device when a third of the three buttons is depressed” is not supported by the specification. While this rejection was previously withdrawn, after further review of the cited passages of the specification (col. 12, lines 22-43, col. 14, line 56-col. 15, line 27) by the applicant in the response dated September 28, 2004, these cited passages do not teach one of ordinary skill in the art to reasonably conclude that when a third of the three buttons is depressed there is manipulation of the lever input device. The specification teaches where when the third button is depressed, scrolling takes place within the displayed window. With respect to claims 10-12, 15 and 16, these claims are also rejected under 35 USC 112, first paragraph as they depend upon a rejected base claim.

As these claims have been amended to include the objected to subject matter of claims 15 and 16, they would be allowable if the 35 USC 112, first paragraph rejection is overcome.

*Response to Arguments*

5. Applicant's arguments filed September 5, 2007 have been fully considered but they are not persuasive.

In regards to the Pre-Appeal conference request, the finality of the previous office action has been withdrawn as a new grounds of rejection with respect to claim 8 has been issued. As shown above a 35 USC 101 rejection for non statutory subject matter is issued for claim 8.

With regards to the 35 USC 112, first paragraph rejection, this has been maintained. As noted below is the examiner's position with regards to the applicant's arguments.

With respect to applicant's arguments in regards to the 35 USC 112, first paragraph rejection of claims 9-13, Applicant argues where the claims do not claim a manipulation of the lever due to the depression of a third or middle button, but rather that a scroll function is operated by manipulation of the lever input device when the third or middle button is depressed. Examiner, respectfully, disagrees. In claims 9 and 13, applicant claims "to scroll within a displayed window by manipulation of the lever input device when a third of the three buttons is depressed" or "to scroll within a displayed window by manipulation of the lever input device when a middle of the three buttons is depressed". The claim language of "by manipulation of the lever input device" suggests that by depressing the third or middle button, the lever input device is manipulated. This suggestion is not supported by the specification in such a way that one of ordinary skill in the art to reasonably conclude that when a third or middle of the three buttons is depressed there is manipulation of the lever input device. As applicant has pointed out in the

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response to arguments that when a third or middle button is depressed, scrolling takes place in the display window, Examiner suggests the applicant revise the claim language to reflect this limitation and remove an ambiguity with respect to the current claim language.

As applicant has included the allowable subject matter of claims 15 and 16 into claims 9 and 13, claims 9-13 would be allowable if the 35 USC 112, first paragraph rejection is overcome.

*Allowable Subject Matter*

14

1. Claims 1-7 and ~~14-16~~ are allowed.
2. The following is an examiner's statement of reasons for allowance:

With respect to claims 1, 3, 7, and 14, the prior art of record does not disclose an information apparatus having a mouse cursor display function, where the scrolling speed display means for displaying a number of speed indicators during scrolling, the number of displayed speed indicators corresponding to a relative scrolling speed set by said pointing device while scrolling data on said display screen and arranging the speed indicators in a scrolling direction relative to a center of said mouse cursor.

Applicant illustrates in Fig. 6c, the state where the number of displayed speed indicators is changed step by step. The overall scroll period increases, and the scroll speed increases from low to middle to high speed in the downward, upward, left and right directions relative to the initial centrally located display, and where the number of speed indicators is increased to one, to two and to three. Also, as applicant indicates in the specification, while all four directions are shown in Fig. 6c, only the speed indicator corresponding to the current scrolling direction (and in a quantity corresponding to the scrolling speed) will actually appear on the desktop. This embodiment is shown in Fig. 7.

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Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Srilakshmi K. Kumar whose telephone number is 571 272 7769. The examiner can normally be reached on 9:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sue Lefkowitz can be reached on 571 272 3638. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Srilakshmi K Kumar  
Examiner  
Art Unit 2629

SKK  
December 5, 2007

  
SUMATI LEFKOWITZ  
SUPERVISORY PATENT EXAMINER